CUSTOMER NO.: 24498
Serial No. 10/586,116
Final Office Action dated: 10/27/09
Response dated: 01/25/10

PATENT
PD040017

Remarks/Arguments

Applicants have carefully studied the Official Action mailed October 27, 2009. To better point out and claim their invention, applicants have amended claims 1, 2 and 11. New claims 12 and 13 have been added. Ample antecedent basis exists in applicants' specification for the amendments to the claims and the new claims added. No new matter has been added. Following the amendments, claims 1-15 remain in this application.

Examiner's Response to Arguments

Applicants acknowledge the Examiner's response to the previously submitted arguments. Here, the Examiner has argued that Kieu would automatically imply an adaptive synchronization between audio and video. However, Kieu provides an increase of the field frequency from 59.94 Hz to 60Hz, i.e., an increase by just 0.1%. On average, for every 1000th field, Kieu inserts only a single additional field. The resulting delay between audio and video is so small that it will not be noticeable. Those of skill in the art recognize that the translation in movies will give rise to movement of a speaker's mouth in the translated language more than 0.1% different than the original language. Most if not all move viewers do not feel disturbed by such mis-synchrnoization.

In the present invention, however, an increase from 24Hz to 25Hz in the frame frequency gives rise to an increase of 4.2%, i.e., a 42-fold increase over that of Kieu. Applicants assert that the Examiner's response in this respect constitutes an impermissible hindsight reconstruction of applicant's claimed invention, and that one of ordinary skill in the art would not, and indeed, could not look to the teachings of Kieu, take singly or in any combination with the other cited references, to arrive at applicant's claimed invention.

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35 U.S.C. § 103(a) Rejection of claims 1-2 and 7-8

Claims 1-2 and 7-8 stand rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent 6,181,382 in the name of Cong Toai Kieu et al. (hereinafter the "Kieu et al." patent), in view of U.S. Patent Application Publication US2005/0084237, in the name of Charles R. Kellner et al. (hereinafter, the "Kellner et al." application.).

As stated above, Kieu does not disclose or suggest applicants' claimed invention, as set forth in independent claims 1, 2 and 11. Notwithstanding the foregoing, Kieu provides a desired general increase of the fixed frame frequency, whereas Kellner concerns variable drop frames, i.e., an unavoidable decrease of the variable frame frequency. Therefore, one of ordinary skill in the art would not look to the teachings of Kellner to cure the deficiencies of Kieu in arriving at applicants' claimed invention.

The failure of the asserted combination to teach or suggest each and every feature of a claim is fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature*. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). "If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

In view of the above, it is asserted that the Examiner's combination of teachings of Kieu and Kellner fails to meet the statutory requirements of the same set forth in MPEP 2143.03.

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In an effort to further clarify the invention and the Examiner's understanding of the same, applicants have amended claims 1, 2 and 11 to clarify that the field or frames insertion is based on a determination of the maximum amount of presentation delay of the video track relative to the audio track. Support for these amendments exists at page 10, lines 6-9 and 29-31, Figure 9 and page 11, line 22 of applicants' specification. No new matter has been added by these amendments.

35 U.S.C. § 103(a) Rejection of Claims 3-4 and 6

Claims 3-4 and 6 stand rejected under 35 U.S.C. § 103(a), as obvious over Kieu et al., in view of "Kellner et al.", further in view of U.S. Patent 6,240.245 to Naoki Kato et al. (hereinafter, the Kato et al. patent).

Claims 3 and 4 depend from claim 2, whereas claim 6 depends from claim 1. As discussed above, claims 1 and 2 patentably distinguish over the combination of Kieu et al., in view of Kellner. The addition of the Kato et al. patent would not cure the deficiencies of Kieu et al., in view of Kellner. The Kato et al. patent concerns a recording device for recoding in various formats. The Kato et al. patent says nothing about the desirability of controlling field or frame insertion to gain lip synch, as recited in applicants' claims 1and 2. Therefore, the combination of Kieu et al., in view of Kellner, further in view of Kato would not render obvious claims 1 and 2 and dependent claims 3, 4 and 6.

35 U.S.C. § 103(a) Rejection of Claim 5

Claims 5 stands rejected under 35 U.S.C. § 103(a), as obvious over Kieu et al., in view of "Kellner et al.", further in view of U.S. Patent 5,708,719 in the name of Hal P. Greenberger et al. (hereinafter the "Greenberger et al." patent). The Greenberger et al. patent concerns a surround sound system. The Greenberger et al. patent says nothing about the desirability of controlling field or frame insertion to gain lip synch as recited in applicants' claim 1. Therefore, the combination of Kieu et al., in view of Kellner, and in further view of Greenberger et al. does not render obvious independent claim 1 or claim 5 which depends therefrom.

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35 U.S.C. § 103(a) Rejection of Claim 9

Claims 9 stands rejected under 35 U.S.C. § 103(a), as obvious over Kieu et al., in view of Kellner et al., further in view of U.S. Patent 5,563,660 in the name of Ikuo Tsukagoshi (hereinafter, the "Tsukagoshi" patent). The Examiner contends that the combination of Kieu et al. and Kellner et al. teach all of the features of claims 9 except for the motion compensation of the inserted frames or fields which is taught by Tsukagoshi.

Applicants respectfully traverse the rejection of claim 9. As discussed above with respect to the 35 U.S.C. § 103(a) rejection of claims 1 and 2, the combination of Kieu et al. and Kellner et al. does not render obvious such claims. The addition of the Tsukagoshi patent adds nothing to the combination of Kieu et al. and Kellner et al., and would not overcome the deficiencies of this combination discussed above. The Tsukagoshi patent says nothing regarding the desirability of controlling field or frame insertion to gain lip synch, as recited in applicants' claim 1 and incorporated by reference in claim 9. Accordingly, claim 9 patentably distinguishes over the art of record, and applicants request withdrawal of the rejection of this claim.

35 U.S.C. § 103(a) Rejection of Claims 10-11

Claims 10-11 stand rejected under 35 U.S.C. § 103(a), as obvious over Kieu et al., in view of Kellner et al., further in view of Kato et al. and U.S. Patent 6,233,253 to Timothy S. Settle at al. (hereinafter the "Settle et al." patent). The Examiner contends that the combination of Kieu et al. and Kellner et al. and Kato et al. teach all of the features of claims 10 and 11, except conveying flags in a user data field, which the Examiner contends is taught in Settle et al.

Applicants respectfully traverse the rejection of claims 10 and 11. As discussed above with respect to the 35 U.S.C. § 103(a) rejection of claims 1 and 2, the combination of Kieu et al. and Kellner et al. does not render obvious such claims. The addition of the Kato et al. patent adds nothing to the failed the combination of Kieu et al. and Kellner et al., and could not possibly overcome the deficiencies of this combination discussed above. Indeed, Kato et al. says nothing regarding the desirability of controlling field or frame insertion to gain lip synch, as recited in applicants' claim 1 and incorporated by reference in claim 10. Like the Kato et al.

patent, the Settle et al. patent says nothing regarding the desirability of controlling field or frame insertion to gain lip synch. Therefore, the combination of Kieu et al., Kellner et al,. Kato et.al., and Settle et al. completely fails to teach or suggest all of the features of applicants' claim 10. Accordingly, claim 10 patentably distinguishes over the art of record, and applicants request withdrawal of the rejection of these claims.

Independent claim 11, like independent claims 1 and 2, recites the feature of controlling field or frame insertion to gain lip synch. Given that the combination of Kieu et al., Kellner et al. Kato et al. and Settle et al. does not teach this feature of claim 11, the claim patentably distinguishes over the art of record. Applicants request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 11.

Conclusion

In view of the foregoing, applicants solicit entry of this amendment and allowance of the claims. If the Examiner cannot take such action, the Examiner should contact the applicant's attorney at (609) 734-6820 to arrange a mutually convenient date and time for a telephonic interview.

No fees are believed due with regard to this Amendment. Please charge any fee or credit any overpayment to Deposit Account No. 07-0832.

Respectfully submitted,

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